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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/861,231	05/21/1997	HEIKKI ILVESPA	1781-73	1961

7590 01/08/2007  
COHEN PONTANI LIEBERMAN & PAVANE  
551 FIFTH AVENUE  
SUITE 1210  
NEW YORK, NY 10176

EXAMINER
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GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3749

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

08/861,231

Applicant(s)

ILVESPAA, HEIKKI

Examiner

Stephen Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27,29-34,36,37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27,29-34,36,37 and 39-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 07/808,161.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20040126
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: form PTOL 304

## **DETAILED ACTION**

### ***Preliminary Matters***

Upon special program examiner review of the heading named reissue application, it is not yet ready for allowance. Since it under final rejection, prosecution is being re-opened in order for applicant to file the necessary requirements discussed below.

It is noted that claim 27 has been amended to delete that claim such that it is now part of claim 26. However the first line of that claim states the "method of claim 26" which raises concern that the line through claim 27 was not intended and that claim 27 is to be examined as dependent upon claim 26 as a separate claim.

### ***Oath/Declaration***

A new oath or declaration is required because it cannot be amended and should be used in rejecting the pending claims. The oath contains markings which appear to be amendments (please see page 9). The applicant needs to submit a new oath which does not contain such amendment markings. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56. More specifically in this application, the oath should state (from 37 CFR 1.63) "that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be **material to patentability** as defined in § 1.56." but this oath instead refers to information **material to examination** which is not acceptable. The applicant needs to submit a new oath correcting this deficiency.

Claims 1-27, 29-34, 36-37, and 39-41 rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defects in the declaration is set forth in the discussion above in this Office action.

### ***Reissue Applications***

This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

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The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

### ***Remand Issues***

The issues raised by the Board on remand do not appear to be sufficiently addressed, or may have been misunderstood. This is particularly true in regards to Issues 2 and 3 as identified in the Board Remand of July 16, 2001.

With respect to Issue 2, the Board expressed concern that two particular limitations ("passing the paper web through a plurality of top-felted single-tier normal dryer groups" and "subsequently applying sufficient heat and moisture...to thereby control curling of the web" as found in new independent claims 26 and 34) were not supported by the original filed reissue application (or the original patent) per 35 USC 112, first paragraph. Though a previous examiner raised this issue in a subsequent action, it appears that the applicant simply added similar corresponding new matter to the specification to overcome the 112 rejection. It appears that the original patent does not support these particular limitations; the materials newly added to the specification during reissue should not be the sole basis of support as this would also likewise be new matter. The current examiner does not see support, for instance, for the limitation "passing the paper web through a plurality of top-felted single-tier normal dryer groups" anywhere in the original disclosure or patented invention from which this reissue is related.

With respect to Issue 3, the Board expressed concern that some of the admitted prior art in the Background section might not be applicable in a grounds of rejection to claims 26, 28-34, and 36-41. Though the previous examiner addressed this concern in a subsequent action, it seems that the previous examiner might have misconstrued the Board's comments. The Board raised concerns over two sections of the Background. The first section (found in the patent in Column 2, lines 62-66) relates to the use of single-wire draw in conjunction with what the Board took to be normal dryers. The examiner stated (Rejection mailed September 6, 2001, page 6) that this section was actually drawn to inverted dryers. However, it appears that this paragraph begins by talking about normal dryers and then states that "recently" inverted dryers have been used instead; therefore it would appear that the Board had a valid point that this section does discuss single-wire drawn and normal dryers. The second section (found in the patent in Column 3, lines 31-37) relates to spraying steam to effect relaxation in connection with calendaring after drying but that it will not "sufficiently eliminate the tendencies of curling of paper in all cases in an efficient manner". Though the previous examiner addressed this by indicating that "calendaring is not considered to be analogous to the process performed by a normal dryer group", might not address the Board's concern. The Board was concerned that this specification was applicable not to the drying, but the step *subsequent to* drying during which heat and moisture are applied "to thereby control curling of the web". The Board particularly pointed out that the qualifying language in the disclosure (will not "sufficiently *eliminate* the tendencies of curling of paper in all cases in an efficient manner") would still read on the broad claim

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limitation that merely requires *controlling* the curling of the web (not eliminating it). The Board raised it as a question only because they were not certain whether this step was subsequent to drying or not. Since the record is not clear with respect to the Board's concern, applicant is urged to particularly point out and distinctly claim the features of the invention such that no ambiguity exists.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In this application, the limitation "passing the paper web through a plurality of top-felted single-tier normal dryer groups" anywhere in the original disclosure and is construed to be new matter such that the claimed subject matter is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 26-34 and 36-41 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In those claims, calendaring is not reasonably and broadly construed from the originally filed application to be analogous to the process performed by a normal dryer group. Applicant's specification is applicable not to the drying, but the step *subsequent to* drying during which heat and moisture are applied "to thereby control curling of the web". The qualifying language in the specification (will not "sufficiently *eliminate* the tendencies of curling of paper in all cases in an efficient manner") would still read on the broad claim limitation that merely requires *controlling* the curling of the web (not eliminating it). It is not certain from those claims whether this step was subsequent to drying or not. Since the record is not clear with respect to the third issue on remand from the Board's concern, applicant is urged to particularly point out and distinctly claim the features of the invention such that no ambiguity exists.

### ***Conclusion***

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the



shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gravini whose telephone number is 571 272 4875. The examiner can normally be reached on normal weekday business hours (east coast time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Josiah C. Cocks can be reached on 571 272 4874. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMG  
December 13, 2006

*Stephen Gravini*

**Advisory Action**  
**After the Filing of an Appeal Brief**

Application No.

08/861,231

Examiner

Stephen Gravini

Applicant(s)

ILVESPAA, HEIKKI

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The reply filed 08 December 2003 is acknowledged.

1. ☐ The reply filed on or after the date of filing of an appeal brief, but prior to a final decision by the Board of Patent Appeals and Interferences, will not be entered because:

a. ☐ The amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).

b. ☐ The affidavit or other evidence is not timely filed before the filing of an appeal brief.  
See 37 CFR 41.33(d)(2).

2. ☐ The reply is not entered because it was not filed within the two month time period set forth in 37 CFR 41.39(b), 41.50(a)(2), or 41.50(b) (whichever is appropriate). Extensions of time under 37 CFR 1.136(a) are not available.

Note: This paragraph is for a reply filed in response to one of the following: (a) an examiner's answer that includes a new ground of rejection (37 CFR 41.39(a)(2)); (b) a supplemental examiner's answer written in response to a remand by the Board of Patent Appeals and Interferences for further consideration of rejection (37 CFR 41.50(a)(2)); or (c) a Board of Patent Appeals and Interferences decision that includes a new ground of rejection (37 CFR 41.50(b)).

3. ☒ The reply is entered. An explanation of the status of the claims after entry is below or attached.

4. ☐ Other: \_\_\_\_\_